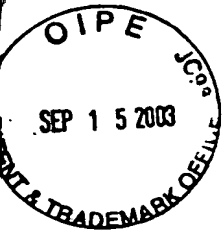


#9
10/17/03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:)
Inventor's Name(s): Michael B. Sundel) Group Art Unit: 3624
Serial No. 09/996,825) Examiner: Geoffrey R. Akers
Filed: November 30, 2001)
For: METHOD AND APPARATUS FOR)
FACILITATING SHIPMENT OF)
PACKAGES)

RECEIVED
SEP 23 2003
GROUP 3600

APPEAL BRIEF

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed July 30, 2003.

I. REAL PARTY IN INTEREST

Worldpak, Inc. is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences known to the Appellant, the Appellant's representative, or the assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-21 are pending. This Appeal is taken from the final rejection of claims 1-21.

IV. STATUS OF AMENDMENTS

Further to the June 13 Final Office Action, Appellant respectfully submits the June 3rd Request for Reconsideration was considered but did not place the application in condition for allowance. No amendments were made to the claims.

V. SUMMARY OF THE INVENTION

The prior art fails to provide a flexible solution for facilitating shipment of items in packages from one destination to another. For example, the prior art provides no flexible means for tracking individual items shipped via a shipper for handling returns or the like. This shortcoming is particularly problematic for international shipments that may be subject to the assessment of duties, taxes and/or customs fees.

Accordingly, a first aspect of the invention is a method for facilitating the shipment of a package containing items from a sender to a recipient via a shipping mechanism. The method comprises storing package data, including item data, in a database, retrieving shipment tracking data from the shipping mechanism, adding the shipment tracking data to the database, correlating the package data in the database with the shipment tracking data; and permitting and authorized user to query the database.

A second aspect of the invention is an apparatus for facilitating the shipment of a package containing items from a sender to a recipient. The apparatus comprises a processor having a database for storing and processing package data including item data, a sender's terminal for selectively communicating with the processing system, a first communications link adapted for selectively enabling communication between the processing system and the sender's terminal, for selectively transmitting the package data from the sender to the processing system, and for selectively transmitting the package data relating to a selected package to the sender's terminal responsive to the sender's query, a shipper's terminal, a second communications link for selectively communicating between the processing system and the shipper's terminal, a customs facilitator terminal, and a third communications link for

selectively communicating between the processing system and the customs facilitator terminal. (See Summary of the Invention).

VI. THE APPLIED REFERENCES

The applied references are:

- 1) U.S. Patent No. 5,664,110 to Green et al. (hereinafter "Green"); and
- 2) U.S. Patent No. 5,897,622 to Blinn et al. (hereinafter "Blinn").

VII. ISSUE

The issue on appeal is whether:

Claims 1-21 are obvious under 35 U.S.C. §103 in view of Green and Blinn.

VIII. GROUPING OF THE CLAIMS

Each claim of this patent application is separately patentable, and upon issuance of a patent would be entitled to a separate presumption of validity under 35 U.S.C. §282. For convenience in handling of this Appeal, the claims will be addressed in seventeen groups as follows:

- Group I.** Claims 1, 6, 8, 11;
- Group II.** Claim 2;
- Group III.** Claim 3;
- Group IV.** Claim 4;
- Group V.** Claims 5;
- Group VI.** Claim 7;
- Group VII.** Claims 9;
- Group VIII.** Claim 10;
- Group IX.** Claims 12 and 18;
- Group X.** Claim 13;
- Group XI.** Claim 14;
- Group XII.** Claim 15;
- Group XIII.** Claim 16;

Group XIV. Claim 17;
Group XV. Claim 19;
Group XVI. Claim 20; and
Group XVII. Claim 21.

Thus, pursuant to 37 C.F.R. §1.192(c)(7), in this Appeal, the rejected claims will stand or fall together only within each group.

IX. ARGUMENTS - GROUPS I - XVII

If all claimed elements/steps are disclosed, expressly or inherently, in a single prior art reference, that reference is said to “anticipate” the claimed invention, thereby invalidating the claim(s) under 35 U.S.C. §102. Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

The Supreme Court in Graham v. John Deere, 383 U.S. 1 at 18, 148 USPQ 459 at 167 (1996), set forth the basic test for patentability under 35 U.S.C. §103:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved need, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter to be patented.

Moreover, in In re Ehrreich and Avery, 200 USPQ 504, 509-510 (CCPA 1979), the Court of Customs and Patent Appeals further clarified the basic test set forth in Graham v. John Deere:

We must not here consider a reference in a vacuum, but against the background of the other references of record which may disprove theories and speculations in the reference or reveal previously undiscovered or unappreciated problems. The question in a §103 case is what the references would collectively

suggest to one of ordinary skill in the art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972). It is only by proceeding in this manner that we may fairly determine the scope and content of the prior art according to the mandate of Graham v. Deere Company, 383 US 1, 17, 148 USPQ 459, 467 (1966). (Emphasis in original.)

Thus, the mere fact that parts of prior art disclosures can be combined does not make the combination obvious unless the prior art also contains something to suggest the desirability of the combination. In re Imperato, 486 F.2d 585 (CCPA 1973).

To imbue one of ordinary skill in the art with knowledge of the invention, when no prior references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1533, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

Further, analyzing the claimed invention as a whole in view of the prior art as a whole, one indicium of nonobviousness is a “teaching away” from the claimed invention by the prior art at the time the invention was made. See U.S. v. Adams, 148 USPQ 479 (1966).

Essentially, teaching away from a claimed invention is a *per se* demonstration of lack of *prima facie* obviousness.

Where the prior art provides “only general guidance and is not specific as to the particular form of the invention or how to achieve it, [such a suggestion] may make an approach ‘obvious to try,’ but it does not make the invention obvious.” Ex parte Obukowicz, 27 USPQ2d, 1063, 1065 (U.S. Patent and Trademark Office Board of Appeals and Interferences, 1992) and In re O’Farrell, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Further, in In re Wright, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988), the Federal Circuit stated:

Factors including unexpected results, new features, solution of a different problem, novel properties are

all considerations in the determination of obviousness...

These secondary considerations (objective evidence of non-obviousness) as outlined in Graham v. John Deere and further characterized in In re Wright must be evaluated before reaching an ultimate decision under 35 U.S.C. §103.

It should be noted that three criteria must be met to establish a *prima facie* case of obviousness. *M.P.E.P.* §2143. First, there must be some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Rhinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). Last, the prior art must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Applicants respectfully contend that the Office Action has failed to set forth a *prima facie* case of obviousness since each cited reference, either alone or in combination, fails to teach, disclose or suggest all limitations recited in the claimed invention.

In the present Application, the Examiner has failed to establish the required *prima facie* case of obviousness. In particular, the cited reference fails to teach, suggest or disclose all of the claimed features. Specifically, the cited reference at least fails to teach, suggest or disclose package data including item data and shipment tracking data as claimed. Accordingly, since the cited reference fails to teach, suggest or disclose each and every claimed feature, the reference can not anticipate nor render obvious the claimed invention.

X. THE CITED REFERENCES DO NOT TEACH, SUGGEST OR DISCLOSE THE CLAIMED INVENTION OF GROUP I

Specifically, Green and Blinn at least fail to teach, suggest or disclose the package data, item data and shipment tracking data as claimed.

Specifically, claim 1 recites, *inter alia*, storing package data, including item data, in a database, retrieving shipment tracking data from the shipment mechanism,

adding the shipment tracking data to the database and correlating the package data in the database with the shipment tracking data.

In contrast, Green is directed toward a remote ordering system. In particular, the remote ordering system of Green provides a user the ability to build and edit one or more order lists, resident in memory within a user device, and the further ability to review and manipulate a user interpretable display of the contents of such a list. While Green generally discusses on columns 12 and 13 the ability to confirm an order, execute the order and provides a delivery option screen 120 (illustrated below in Fig. 9), Green does not teach, suggest or disclose any methodology, nor hardware that is capable of performing the functions and steps recited in claim 1. In particular, Green fails to teach, suggest or disclose the granularity of the package contents and the actual shipping data as claimed.

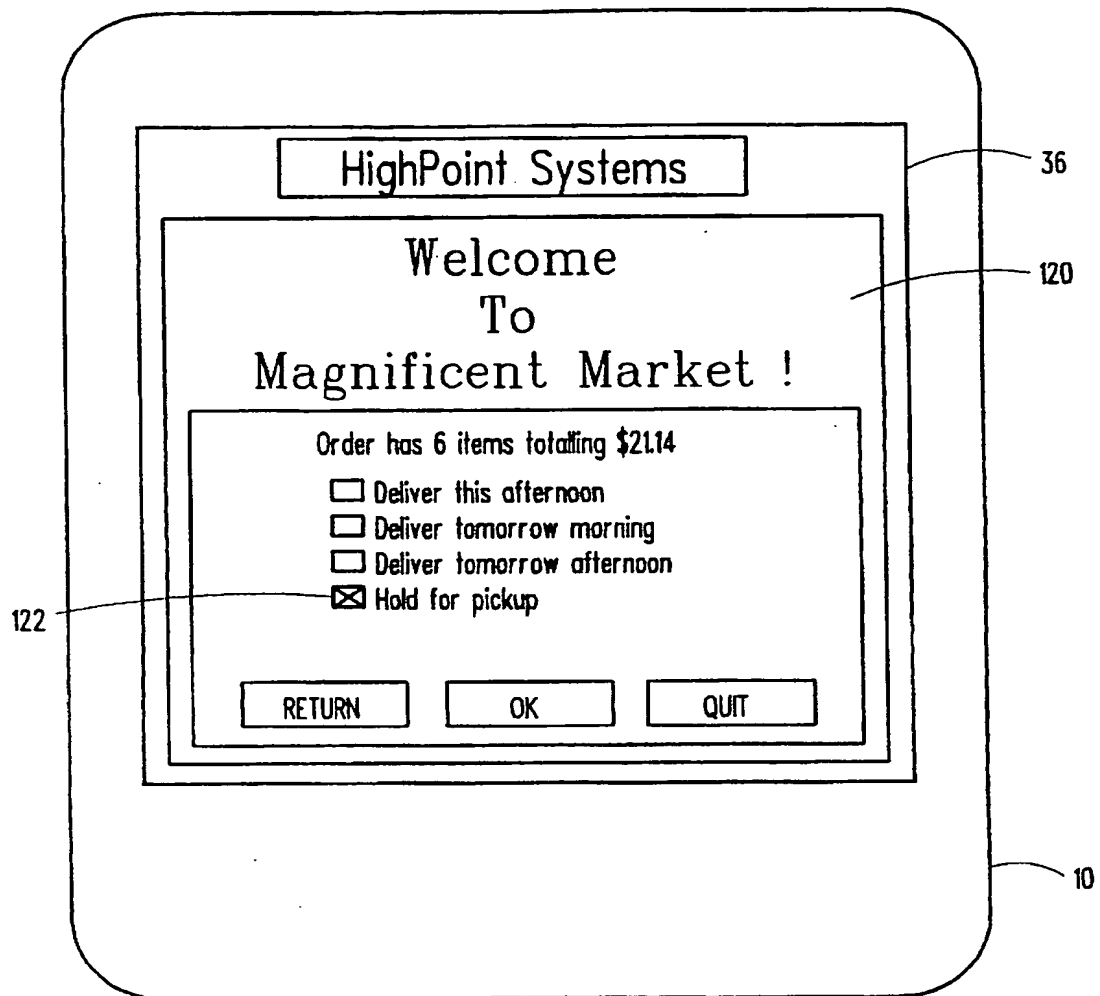


FIG. 9

Appellant respectfully submits it is clear from both the figures and corresponding specification of Green, that Green is directed toward a *remote ordering system* and only discloses specifics related to the remote ordering system. As close as Green gets to discussing any type of shipping is on column 5 where Green recites “the computer 12 can verify that the merchandise database 14 reflects availability of a sufficient quantity of the items requested and can confirm the preferred mode of payment and order delivery, both for the user and the merchant, by searching the

merchant database 14," see lines 56-61 and the corresponding description of Fig. 9 on column 12, lines 60-65.

Accordingly, Appellant respectfully submits that since Green is not concerned with shipping information, Green would necessarily not teach, suggest or disclose correlating package data, that includes item data, with the shipment tracking data as claimed.

Further in contrast, Blinn is related to an electronic shopping and merchandising system. However, as with Green, while Blinn discusses order processing product tables and the like, Blinn is entirely directed toward the interfaces used for order processing, and not the correlation of package data and shipment tracking data as claimed. While Blinn generally discloses the ability of shoppers to select shipping methods and provide delivery instructions for the order, Blinn at least fails to teach, suggest or disclose correlating the data as claimed. Specifically, Blinn recites on col. 8, first full paragraph:

To support consumer purchases, the merchant system 120 includes a basket.html page having an interface that allows shoppers to manipulate items in their shopping baskets, the online equivalent of a shopping cart or handheld basket. Similarly, an orderfrm.html page provides an order form display for shoppers to select shipping methods and to provide delivery instructions for the order. A purchase.html page presents the order total and provides a form for entry of credit card payment information. To confirm purchases, a confirmed.html page presents a message confirming completion of the purchase transaction. Similarly, a receipt.html page presents a summary of the order in the form of an online checkout receipt. In addition, a detail.html page presents a detailed line item receipt for items ordered. Lastly, a receipts.html page presents receipts from all orders placed by a particular shopper.

The Office points to column 13 lines 9-19 of Green (reproduced below) asserting that it teaches "including shipper and shipping information." Appellant has

reproduced this portion of Green below and respectfully submits that neither this portion nor any other portion of Green teach the correlation of data as claimed.

Once the user has responded to whatever option screens are provided, depending upon the configuration of the ordering system, telephonic communication between the DPU 10 and the DFTC 12 is terminated, as in step 277. From the point of view of the user, a final step in the ordering process can be a list disposition option screen 130, as shown in FIG. 10. This screen 130 provides the user with the ability, through the use of response icons 134, to print the current order list 52, to generate a new blank order list, to return to the order list 52 just completed, or to store the order list 52 within RAM 34, as reflected in step 279 of FIG. 14.

In an alternative embodiment, the list disposition option screen 130 can provide the user the opportunity to store the current option order list 52 as one of several user selectable order lists. Such an alternative embodiment can further provide the user the ability to recall one of several stored order lists. An option menu can provide a textual description of stored order lists available, or such stored lists can be made available via descriptive icons.

From the point of view of the merchant database 14, the final step in the ordering process, as reflected in step 278 of FIG. 14, is to update the merchant database 14 to reflect the user order just processed. Thus, in addition to providing a convenient way for a user to compile and order a list of needed products, the present system enables automated maintenance of merchant inventory.

However, Appellant respectfully submits that based on this paragraph, it is abundantly clear that the final step in the ordering process, as reflected in step 278 of Fig. 14 of Blinn below, is to update the merchant database 14. There is no teaching, suggestion or disclosure in Green of retrieving shipment tracking data from a shipping mechanism nor correlating the package data as claimed.

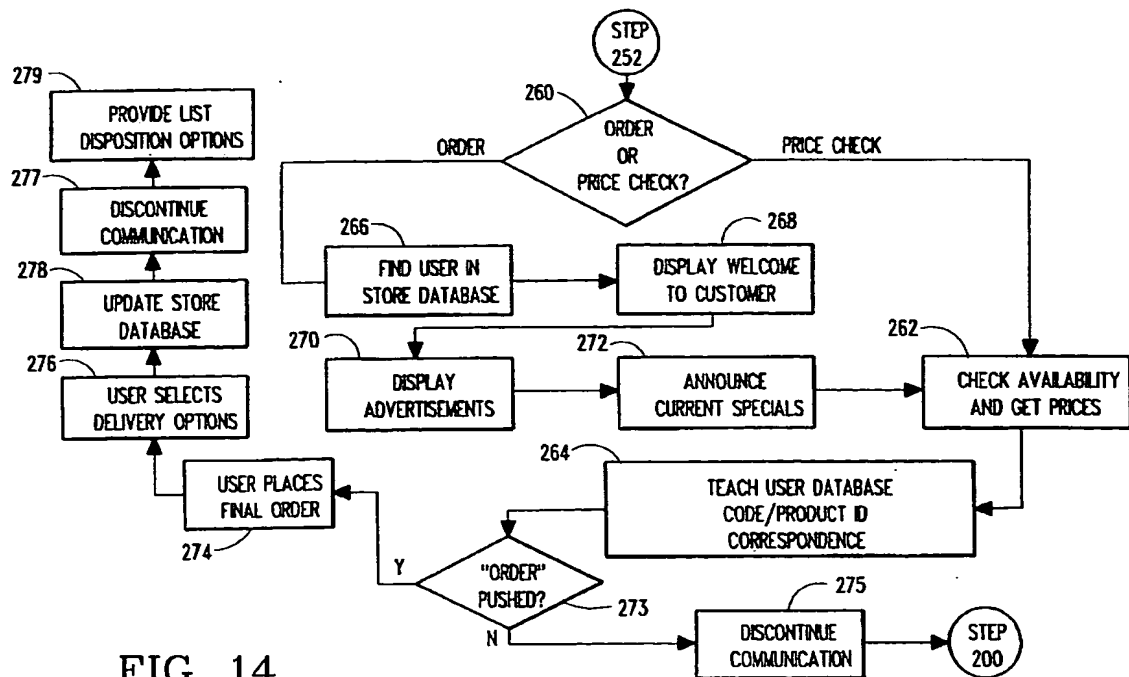


FIG. 14

Accordingly, Appellant respectfully submits that neither Green nor Blinn teach, suggest or disclose storing package data, including item data, in a database, retrieving shipment tracking data from the shipping mechanism, adding the shipment tracking data to the database and correlating the package data in the database with the shipment tracking data.

A. Conclusion

Accordingly, for at least the reasons outlined above, Appellant respectfully submits that Green and Blinn, either alone or in combination, fail to teach, suggest or disclose, either expressly or inherently, each and every feature of the claimed invention of Group I. Thus, the cited references can not anticipate nor render obvious the claimed invention.

XI. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP II

The claimed invention of Group II is generally directed toward package assignment.

In particular, claim 2 recites, *inter alia*, assigning the package to a specific

combination of a shipper and shipping method based on the package data.

Appellant respectfully submits that even though Blinn discloses the ability to select shipping methods, neither Green nor Blinn discuss assigning the package to a specific combination of a shipper and shipping method as claimed.

Accordingly, Appellant respectfully submits that not only do the cited references fail to assign the package to a specific combination of a shipper and shipping method, the references also fail to make the assignment based on the package data as claimed.

A. Conclusion

Accordingly, Appellant respectfully submits that the cited references fail to teach, suggest or disclose at least the above features. Thus, the cited references can not anticipate, nor render obvious, the claimed invention.

Accordingly, for at least the reasons set forth above, the cited references fail to teach, either expressly or inherently, suggest or disclose each and every feature of the claimed invention of Group II. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references do not teach, suggest or disclose each and every feature of the claim, the invention claimed in Group II would not have been obvious to one of ordinary skill in the art.

XII. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP III

In addition to the features discussed above, the claimed invention of Group III further specifies determining whether the package requires a custom clearance, and if so, generating the appropriate customs documentation or data transmission to a customs broker.

Appellants have searched both the Green and Blinn reference and can find absolutely no teaching or suggestion of the claimed features. In particular, since neither Blinn nor Green are directed toward shipping, but rather to ordering, the systems of Green and Blin would not have been concerned with customs, customs documentation, or a customs broker.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references, either alone or in combination, either expressly or inherently, fail to teach, suggest or disclose each and every feature of the claimed invention of Group III. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references does not teach, suggest or disclose each and every feature of the claimed invention, the claimed invention of Group III would not have been obvious to one of ordinary skill in the art.

XIII. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP IV

In addition to the features discussed above, the claimed invention of Group IV further generates invoices associated with the shipment.

In particular, claim 4 recites, *inter alia*, using the package data, that includes at least the originating address and the destination address, and the item data includes a description of the items in the package, to calculate shipping charges and generate invoices associated with the shipment.

Again, while Green recognizes that there can be items within an order, Green at least fails to teach, suggest or disclose using a package data, that includes item data, to calculate shipping charges and generate invoices as claimed.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, either expressly or inherently, suggest or disclose each and every feature of the claimed invention. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references do not teach, suggest or disclose each and every feature of the claimed invention, the claimed invention of Group IV would not have been obvious to one of ordinary skill in the art.

XV. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP V

In addition to the features discussed above, the claimed invention of Group V further specifies that the item data includes the description and value of each item.

As discussed above, the cited references fail to teach, suggest or disclose the hierarchical nature of package data including item data. Thus, the cited references would inherently not teach, suggest or disclose package data that includes item data where the item data includes the description and value of each item. At least based on this distinction, Appellant respectfully submits the references do not teach, suggest or disclose each and every claimed feature.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, either expressly or inherently, suggest or disclose, each and every feature of the claimed invention of Group V. Thus, the cited reference cannot anticipate the claimed invention. Furthermore, since the cited reference does not teach, suggest or disclose each and every feature of the claimed invention, the claimed invention of Group V would not have been obvious to one of ordinary skill in the art.

XVI. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP VI

In addition to the features discussed above in relation to the claimed invention of Group IV, Group VI further specifies that the permitting step includes a receiving and transmitting step. In particular, claim 7 recites, *inter alia*, wherein the permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network in response to the query parameters. Given the dependency of claim 7 from claim 4, which depends from claim 1, the permitting step allows an authorized user to query the database. The database stores package data, including item data. However, as discussed above, neither the Green nor the Blinn reference teach, suggest or disclose this feature. Accordingly, the cited reference would inherently not disclose the permitting step as claimed.

A. Conclusion

For at least the reasons set forth above, the cited references fail to teach, either

expressly or inherently, suggest or disclose each and every feature of the claimed invention of Group VI. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references do not teach, suggest or disclose each and every feature of the claimed invention, the claimed invention of Group VI would not have been obvious to one of ordinary skill in the art.

XVII. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP VII

Claim 9 recites, *inter alia*, adding returned item information to the database if items from the package are returned to the Sender, in the case of international shipments, preparing duty and tax refund claims based on the returned item information and the corresponding item data, and adding duty and tax refund information to the database.

Again, as Appellant discussed above, both the cited references are concerned with ordering systems. Appellants have carefully searched each of the references, and can find no teaching, suggestion or disclosure of the concept of returned item information as claimed. Furthermore, since the concept of returned item information is not addressed, there would inherently be no disclosure associated with international shipments and tax and duty refund information as recited in claim 9.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, either expressly or inherently, suggest or disclose each and every feature of the claimed invention of Group VII. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references do not teach, suggest or disclose each and every feature of the claimed invention, the claimed invention of Group VII would not have been obvious to one of ordinary skill in the art.

XVIII. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP VIII

Claim 10 recites, *inter alia*, said permitting step comprises receiving a query

over a computer network and transmitting data from the database over the computer network in response to the query parameters. As discussed above, since the cited references fail to teach, suggest or disclose a database that stores package data including item data, Appellant respectfully submits the references also fail to permit a user to query the database in accordance with the features specified in claim 10.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, either expressly or inherently, suggest or disclose each and every feature of the claimed invention of Group VIII. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references do not teach, suggest or disclose each and every feature of the claimed invention, the claimed invention of Group VIII would not have been obvious to one of ordinary skill in the art.

XIX. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP IX

Claim 12 recites, *inter alia*, an apparatus for facilitating the shipment of package containing items from a Sender to a Recipient comprising a processor having a database for storing and processing package data, the package data including item data, a Sender's terminal for selectively communicating with said processing system, a first communications link adapted for selectively enabling communication between said processor and said Sender's terminal, for selectively transmitting the package data from said Sender's terminal to said processing system, and for selectively transmitting said package data relating to a selected package to said Sender's terminal responsive to a request, a shipper's terminal, a second communications link for selectively communicating between said processing system and said shipper's terminal, a customs facilitator terminal and a third communications link for selectively communicating between said processor and said customs facilitator terminal.

Appellants respectfully submit that while Green and Blinn may discuss items

within an order, neither Green nor Blinn discuss package data where the package includes item data. Furthermore, neither Green nor Blinn teach, suggest or disclose a shipper's terminal, a customs facilitator terminal nor the communications links as claimed. Appellants respectfully submit at least neither of these features are present in either of the cited references.

Thus, as discussed through out prosecution, the systems of Green and Blinn could be used as a "front-end" to aspects of Appellant's invention, where the systems of Green and Blinn handle the order side of the transaction, and the aspects of the Appellant's invention handle the shipping side of the transaction. Nevertheless, while the system of Appellant's invention could be used with the systems of Green and Blinn, neither Green nor Blinn teach, suggest or disclose any of the claimed features.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, either expressly or inherently, suggest or disclose each and every feature of the claimed invention of Group IX. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references do not teach, suggest or disclose each and every feature of the claimed invention, the claimed invention of Group IX would not have been obvious to one of ordinary skill in the art.

XX. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP X

Claim 13 recites, *inter alia*, wherein said processing system is adapted to select a shipping assignment for the package based on information comprising package data.

In contrast, and as illustrated in Fig. 9 of Green, the user selects delivery or pick-up options. However, it is the user that selects from the four options not *a shipping assignment based on information comprising package data* as claimed.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, either expressly or inherently, suggest or disclose each and every feature of the

claimed invention of Group X. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references do not teach, suggest or disclose each and every feature of the claimed invention, the claimed invention of Group X would not have been obvious to one of ordinary skill in the art.

XXI. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP XI

Claim 14 recites, *inter alia*, wherein said processing system is further adapted to generate appropriate shipping documents for the package.

Again, as discussed above, neither the systems of Green nor Blinn teach an apparatus for facilitating the shipment of a package as claimed nor the ability to generate shipping documents as recited in claim 14.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, suggest or disclose the above-identified feature. Thus, the cited references cannot anticipate, nor render obvious, the claimed invention.

XXII. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP XII

Claim 15 recites, *inter alia*, wherein said shipping documents comprise package labels.

Since claim 15 depends from claim 14, which depends from claim 12, Appellant respectfully submits that for at least the reasons outlined above and the additional features recited in claim 15, the cited references also fail to teach or suggest shipping documents comprising package labels.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, suggest or disclose the above-identified feature. Thus, the cited references cannot anticipate, nor render obvious, the claimed invention.

XXIII. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP XIII

Claim 16 is generally directed toward shipping documents.

In particular, claim 16 recites, *inter alia*, wherein said shipping documents comprise shipping manifests. However, as discussed above, since neither Blinn nor Green are concerned with shipping, neither Blinn nor Green disclose the claimed feature nor would have had any motivation to suggest the claimed feature.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, suggest or disclose the above-identified feature. Thus, the cited references cannot anticipate, nor render obvious, the claimed invention.

XXIV. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP XIV

Claim 17 recites, *inter alia*, wherein said shipping documents comprise customs forms.

As discussed above, Appellants have searched both the Green and Blinn references and can find absolutely no teaching, suggestion or disclosure of customs nor customs forms.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, suggest or disclose the above-identified feature. Thus, the cited references can not anticipate nor render obvious, the claimed invention.

XXV. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP XV

Claim 19 recites, *inter alia*, wherein said processing system includes a web site page selectively accessible via one of said terminals. However, as discussed

above, since the cited references fail to teach, suggest or disclose at least a customs facilitator terminal and a shipper's terminal, the cited references can also not teach a web cite page selectively assessable via one of said terminals.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, suggest or disclose the above-identified feature. Thus, the cited references can not anticipate, nor render obvious, the claimed invention.

XXVI. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE CLAIMED INVENTION OF GROUP XVI

Claim 20 recites, *inter alia*, wherein said processing system is adapted to generate duty and tax refund claims based upon receipt of returned item data. The Office Action points to Figure 2, and in particular component 132 that is part of the order processing module 129. However, as discussed in Blinn, component 132 is used for various purposes "such as calculating sales tax and shipping/handling fees." Blinn goes on further to state that "the order processing module 129 includes component 132, that is, a plurality of application programs to enhance and administer the merchant system 120. For example, the components 132 can include applications to interface with commercial banking systems, to calculate shipping/handling, to determine applicable taxes and to post payments to various bank accounts.

However, Blinn at no point discusses refund claims based upon receipt of *return item* data as claimed. In contrast, component 132 of Blinn is for outbound shipping/handling fees.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, suggest or disclose the above-identified feature. Thus, the cited references cannot anticipate, nor render obvious, the claimed invention.

XXVII. THE CITED REFERENCES DO NOT TEACH OR SUGGEST THE

CLAIMED INVENTION OF GROUP XVII

Claim 21 recites, *inter alia*, wherein said processor is operative to add returned item information to said database if items from a package are returned to the Sender, and to prepare duty and tax refund claims based on the returned item information.

As discussed above, neither Blinn nor Green address the issue of returned items, nor the ability to prepare duty and tax refund claimed based on the returned item information as claimed.

A. Conclusion

Accordingly, for at least the reasons set forth above, the cited references fail to teach, suggest or disclose the above-identified features. Thus, the cited references cannot anticipate, nor render obvious, the claimed invention.

XXVIII. SUMMARY

Accordingly, for at least the reasons stated above, the cited references fail to teach, suggest or disclose, either expressly or inherently, either alone or in combination, each and every feature of the claimed invention as set forth in groups I-XVII. Thus, the cited references cannot anticipate the claimed invention. Furthermore, since the cited references does not teach or suggest each and every feature of the claimed invention, the claimed invention of Groups I-XVII would not have been obvious to one of ordinary skill in the art based on the teachings of the cited references.

XXIX. CONCLUSION

Thus, at least for the foregoing reasons, the cited references do not anticipate, nor can render obvious, the claimed invention. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

For all of the reasons discussed above, it is respectfully submitted that all claims 1-21 define patentable subject matter under 35 U.S.C. §103. Accordingly, Appellant respectfully requests this Honorable Board to reverse the rejection of claims 1-21.

Respectfully submitted,



Jason H. Vick
Registration No. 45,285

September 15, 2003

Nixon Peabody LLP
8180 Greensboro Drive – Suite 800
McLean, Virginia 22102

APPENDIX

1. A method for facilitating the shipment of a package containing items from a Sender to a Recipient via a shipping mechanism, the method comprising the steps of:

storing package data, including item data, in a database;
retrieving shipment tracking data from the shipping mechanism;
adding the shipment tracking data to the database;
correlating the package data in the database with the shipment tracking data;
and
permitting an authorized user to query the database.

2. The method of Claim 1, further comprising the step of:
assigning the package to a specific combination of a shipper and shipping method based on the package data.

3. The method of Claim 1, further comprising the step of:
determining whether the package requires customs clearance and, if so, generating the appropriate customs documentation or data transmission to a customs broker.

4. The method of Claim 1, wherein the package data includes at least the originating address and the destination address, and the item data includes a description of the items in the package, said method further comprising the step of:

using the package data to calculate shipping charges and generate invoices associated with the shipment.

5. The method of Claim 4, wherein the item data includes the description and value of each item.

6. The method of Claim 4, wherein the step of storing package data comprises transmitting package data via the Internet.

7. The method of claim 4, wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network in response to the query parameters.

8. The method of Claim 7, wherein the computer network comprises the Internet.

9. The method of Claim 1, further comprising the steps of:
adding returned item information to the database if items from the package are returned to the Sender;
in the case of international shipments, preparing duty and tax refund claims based on the returned item information and the corresponding item data; and
adding duty and tax refund information to the database.

10. The method of claim 9, wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network in response to the query parameters.

11. The method of Claim 10, wherein the computer network comprises the Internet.

12. An apparatus for facilitating the shipment of a package containing items from a Sender to a Recipient, comprising:
a processor having a database for storing and processing package data, the package data including item data;
a Sender's terminal for selectively communicating with said processing system;
a first communications link adapted for selectively enabling communication between said processor and said Sender's terminal, for selectively transmitting the

package data from said Sender's terminal to said processing system, and for selectively transmitting said package data relating to a selected package to said Sender's terminal responsive to a request;

a shipper's terminal;

a second communications link for selectively communicating between said processing system and said shipper's terminal;

a customs facilitator terminal; and

a third communications link for selectively communicating between said processor and said customs facilitator terminal.

13. The apparatus of Claim 12, wherein said processing system is adapted to select a shipping assignment for the package based on information comprising package data.

14. The apparatus of Claim 12, wherein said processing system is further adapted to generate appropriate shipping documents for the package.

15. The apparatus of Claim 14, wherein said shipping documents comprise package labels.

16. The apparatus of Claim 14, wherein said shipping documents comprise shipping manifests.

17. The apparatus of Claim 14, wherein said shipping documents comprise customs forms.

18. The apparatus of Claim 12, wherein at least one of said communication links is the Internet.

19. The apparatus of Claim 12, wherein said processing system includes a

Web site page selectively accessible via one of said terminals.

20. The apparatus of Claim 12, wherein said processing system is adapted to generate duty and tax refund claims based upon receipt of returned item data.

21. The apparatus of claim 12, wherein said processor is operative to add returned item information to said database if items from a package are returned to the Sender, and to prepare duty and tax refund claims based on the returned item information.